



04-02-04

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Attorney Docket No. 35693.830007.US0  
Express Mail Label No. EV268509809US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

KERNS ET AL.

Serial No. 10/665,909

Filed: September 18, 2003

For: MULTI-DENSITY LASTING BOARD

Examiner: Not Yet Assigned

Art Unit: not yet assigned

CERTIFICATE OF MAILING BY EXPRESS MAIL

Mail Stop: Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

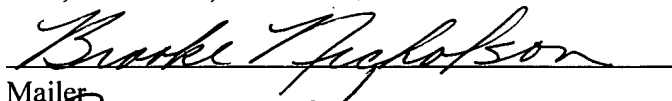
Sir:

The undersigned hereby certifies that the enclosed

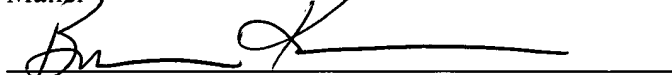
1. Certificate of Mailing by Express Mail;
2. Response to Decision of March 9, 2004, and Request for Reconsideration of Petition under 37 CFR §1.47(a) Requesting Waiver of Signature by Mr. Noah Bernard;
3. COPY of Decision Refusing Status Under 37 CFR 1.47(a);
4. COPY of Supplemental Declaration from Mark Kerns; and
5. Return Card,

relating to the above application, were deposited as "Express Mail," Mailing Label No. EV268509809US with the United States Postal Service, addressed to Mail Stop: Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. .

March 31, 2004

  
\_\_\_\_\_  
Mailer

March 31, 2004

  
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Brian P. Kinnear, Reg. No. 43,717  
HOLLAND & HART LLP  
555-17th Street, Suite 3200  
Post Office Box 8749  
Denver, Colorado 80201  
Telephone: (303) 295-8170  
Facsimile: (303) 295-8261



PATENT  
Attorney Docket No. 35693.830007.US0  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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KERNS et al.

Serial No. 10/665,909

Filed: September 18, 2003

For: MULTI-DENSITY LASTING BOARD

Examiner: not yet assigned

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RESPONSE TO DECISION OF MARCH 9, 2004, AND  
REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 C.F.R. § 1.47(a) REQUESTING  
WAIVER OF SIGNATURE BY MR. NOAH BERNARD

Mail Stop: Petition  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313

Sir:

In light of the below statement and the attached supplemental declaration, the applicants hereby request reconsideration and allowance from the Commissioner to waive the requirement that Mr. Noah Bernard sign the declaration in this case. As demonstrated by the previously submitted petition, Mr. Bernard cannot be located and Mr. Bernard had an obligation to assign his rights in the application to DashAmerica, Inc., as shown by the Employment Contract attached as Exhibit A to the petition filed on January 29, 2004.

While no fee is believed necessary, please charge Deposit Account No. 08-2623 for any others fees that may be required for consideration of this petition.

FACTS IN SUPPORT

The factual account below is based on actual knowledge to those facts performed by the undersigned attorney.

1. On March 9, 2004, the United States Patent Office refused status under 37 C.F.R. 1.47(a) because the petition "have not provided proof that Bernard was ever sent or presented with a copy of the application as filed."  
  
Moreover, it was unclear whether the facts stated in the petition related to statements made by a person with first-hand knowledge that the documents were in fact sent.
2. The undersigned attorney states that facts associated with the petition filed on January 29, 2004, were performed by the undersigned attorney.
3. Further, Exhibit 1 to this statement contains the letter sent to Mr. Bernard's last known address of 410 Washington #13, Santa Fe, New Mexico 87501-1970. This letter forwarded a copy of the filed application and requested Mr. Bernard to review the application and either sign the declaration or contract the undersigned attorney. Exhibit C to the petition filed on January 29, 2004, shows this letter (with the filed application) was received and accepted by Mr. Bernard on January 12, 2004. Despite the delivery of the package and the request, neither the application nor the undersigned attorney have been contacted by Mr. Bernard.
4. In view of these additional facts, the facts contained in the petition filed on January 29, 2004, and the supplemental declaration filed herewith, the petitioners respectfully request reconsideration of the petition filed on January 29, 2004, and the granting of said petition.

Therefore, it is respectfully requested that this petition be granted and Mr.

Bernard's signature be waived on the Declaration.

Signed this 31 day of March 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian Kinnear", written over a horizontal line.

Brian Kinnear, Reg. No. 43,717  
Holland & Hart LLP  
555 17<sup>th</sup> Street, Suite 2700  
Denver, CO 80202  
Telephone: (303) 295-8000  
Facsimile: (303) 295-8261

3206228\_1.DOC



January 9, 2004

**VIA UPS OVERNIGHT SIGNED RECEIPT REQUESTED**

Mr. Noah Bernard  
410 Washington #13  
Santa Fe, New Mexico 87501-1970

Re: Newly Filed United States Patent Application  
TITLE: Multi-Density Lasting Board  
H&H Ref.: 35693.830007.US0

Dear Mr. Bernard:

Holland & Hart LLP represents DashAmerica, Inc d/b/a Pearl Izumi in intellectual property matters. Recently, we filed a patent application for Pearl Izumi relating to a multi-density lasting board. In particular, the patent application related to a lasting board having ergonomically placed different density foams.

As a condition of your employment with Pearl Izumi, you entered an Agreement on November 5, 2002, a copy of which is enclosed (the "Agreement"). Paragraph four of the Agreement states "that all work and products I may create or develop during work hours for the company or using the company's premises or any of its equipment or supplies, are work made for hire that belongs to the company and will remain the company's property." Thus, you have already acknowledged that Pearl Izumi owns the entire right, title, and interest in the shoe tightening system invention.

Even though Pearl Izumi owns the invention pursuant to the Agreement, in the United States, the inventors of an invention for which a patent application is filed should sign a declaration that they are the original, first and joint (or sole) inventors of a claimed invention. Pearl Izumi believes you may be an inventor of one or more aspects of the above-referenced patent application.

Thus, in accordance with your obligations, please review the attached patent application, and if you believe you are an inventor, please sign the declaration where indicated and return the same to me in the enclosed overnight envelope. If you do not believe you are an inventor, please let me know as soon as possible.



Also included with this correspondence is an assignment of the invention contained in the patent application to Pearl Izumi. This assignment formalizes your obligation to assign the invention to Pearl Izumi and is in accordance with paragraph four of the Agreement. Please execute the assignment were indicated and return the same to me in the enclosed overnight envelope as well.

We request that you review the patent application, and execute the declaration and assignment as soon as possible, but in no event later than January 30, 2004. If we have not received the executed documents by January 30, 2004, we will assume you are refusing to sign the documents. If you refuse to sign the documents, we will proceed with this patent application by requesting that the Patent Office waive the requirements that you sign, which requests are normally granted.

If you have any questions regarding the above, we would be happy to answer them for you. Thank you for your cooperation and prompt attention to this matter.

Sincerely,

Brian P. Kinnear  
for Holland & Hart LLP

Enclosures

**Acknowledgment of Receipt**

I have received a copy of the DashAmerica, Inc. Employee Handbook dated May, 2001. I understand that I am to become familiar with its contents as it outlines my responsibilities, benefits, and company guidelines. If I have any questions or suggestions, I understand that I should talk to my manager or the Human Resources Department.

**I FURTHER UNDERSTAND THAT THE CONTENTS OF THIS HANDBOOK DO NOT CONSTITUTE AN EXPRESS OR IMPLIED CONTRACT OF EMPLOYMENT. BOTH THE COMPANY AND I REMAIN FREE TO END OUR RELATIONSHIP AT ANY TIME, WITH OR WITHOUT CAUSE, AND WITHOUT ADVANCE NOTICE, PROCEDURE, OR TIME FORMALITY.** This handbook represents **BRIEF SUMMARIES** of DashAmerica, Inc. guidelines which are subject to change or revocation at any time and so this handbook may not be all-inclusive.

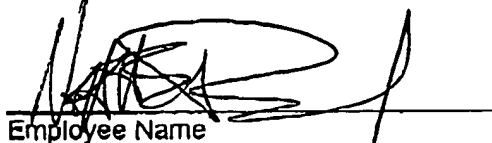
I will preserve the secrecy of all trade secrets and other proprietary and confidential information belonging to the company, both while I am employed with the company and afterwards, and I will not take or misuse any confidential information at anytime. I also agree that, on the company's request or on termination of my employment, I will promptly return to the company all its property, specifically including all documents, disks, or other computer media or other materials in my possession or under my control that contain ideas, processes, concepts, or other trade secrets or proprietary and confidential information belonging to the company.

I understand and agree that all work and products I may create or develop in the scope of my employment, including any work or products I create or develop during work hours for the company or using the company's premises or any of its equipment or supplies, are work made for hire that belongs to the company and will remain the company's property.

I understand that the company will give references to potential employers on my request or if requested by potential employers unless I give the company a written notice asking it not to give references for me. I release the company and hold it harmless concerning any information it may give about my job performance to potential employers, so long as the company provides that information in good faith.

I understand and agree that any disputes that arise between the company and me that cannot be resolved informally shall be decided by submission of the dispute to binding arbitration before a professional arbitration organization selected by DashAmerica, Inc.. **I acknowledge and agree that I am agreeing to waive to the maximum extent permitted by law any right to have any such dispute decided in a court of law before a jury, and instead am accepting the use of the arbitration process.** The arbitrator's procedures or rules then in effect for employment disputes will govern any arbitration between the company and me, and the arbitration shall take place in the Denver, Colorado metro area. I agree that each party shall bear its own costs and attorneys fees incurred in connection with the arbitration. The arbitrator's fees shall be born equally by the parties. Notwithstanding the foregoing, the arbitrator shall have the discretion to award attorney fees, arbitrator's fees, and costs to the prevailing party.

After reviewing the above, please sign both copies of the acknowledgment and return one to your manager.


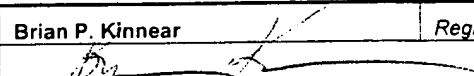
  
Employee Name

11-5-02  
Date

Please type a plus sign (+) inside this box ☐

PTO/SB/05 (03-01)  
Approved for use through 10/31/2002 OMB 0651-0032  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>UTILITY PATENT APPLICATION TRANSMITTAL</b>		Attorney Docket No. <b>35693.830007.US0</b>	
		First Inventor <b>Mark Kerns et al.</b>	
		Title <b>MULTI-DENSITY LASTING BOARD</b>	
(Only for new nonprovisional applications under 37 CFR 1.53(b))		Express Mail Label No. <b>EV269463365US</b>	
<b>APPLICATION ELEMENTS</b> <small>See MPEP chapter 600 concerning design patent application contents</small>		<b>ADDRESS TO:</b> Commissioner for Patents Mail Stop: Patent Application Alexandria, VA 22313-1450	
<p>1. <input checked="" type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) <small>(Submit an original, and a duplicate for fee processing)</small></p> <p>2. <input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.</p> <p>3. <input checked="" type="checkbox"/> Specification <span style="float: right;">[Total Pages <b>12</b>]</span> <small>(preferred arrangement set forth below)</small> - Descriptive title of the invention - Cross Reference to the Related Applications - Statement Regarding Fed sponsored R &amp; D - Reference to sequence listing, a table or a computer program listing appendix - Background of the Invention - Brief Summary of the Invention - Brief Description of the Drawings (if filed) - Detailed Description - Claim(s) - Abstract of the Disclosure</p> <p>4. <input checked="" type="checkbox"/> Drawings(s) (35 U.S.C. 113) <span style="float: right;">[Total Sheets <b>3</b>]</span></p> <p>5. <input type="checkbox"/> Oath or Declaration <span style="float: right;">[Total Pages <b>    </b>]</span> a. <input type="checkbox"/> Newly executed (original or copy) b. <input type="checkbox"/> Copy from a prior application (37 CFR 1.63(d)) <small>(for continuation/divisional with Box 18 completed)</small> i. <input type="checkbox"/> <b>DELETION OF INVENTOR(S)</b> <small>Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b)</small></p> <p>6. <input type="checkbox"/> Application Data Sheet. See 37 CFR 1.76</p>		<p>7. <input type="checkbox"/> CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)</p> <p>8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary) a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); or ii. <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies</p> <div style="border: 1px solid black; padding: 5px;"><b>ACCOMPANYING APPLICATION PARTS</b> 9. <input type="checkbox"/> Assignment Papers (cover sheet &amp; document(s)) 10. <input type="checkbox"/> 37 CFR 3.73(b) Statement (when there is an assignee) <input type="checkbox"/> Power of Attorney 11. <input type="checkbox"/> English Translation Document (if applicable) 12. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations 13. <input type="checkbox"/> Preliminary Amendment 14. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <small>(Should be specifically itemized)</small> 15. <input type="checkbox"/> Certified Copy of Priority Document(s) <small>(if foreign policy is claimed)</small> 16. <input type="checkbox"/> Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent. 17. <input type="checkbox"/> Other: .....</div>	
<p>18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:</p> <p><input type="checkbox"/> Continuation    <input type="checkbox"/> Divisional    <input type="checkbox"/> Continuation-in-part (CIP)    of prior application No: .....</p> <p>Prior application information: Examiner    Group Art Unit: .....</p> <p><b>For CONTINUATION or DIVISIONAL APPS only:</b> The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.</p>			
<b>19. CORRESPONDENCE ADDRESS</b>			
<input checked="" type="checkbox"/> Customer Number or Bar Code Label		<div style="border: 1px solid black; padding: 10px; display: inline-block;"> <b>26582</b></div>	
		<input type="checkbox"/> Correspondence address below	
Name <b>Brian P. Kinnear</b>			
Address <b>Holland &amp; Hart</b>			
<b>555 17<sup>th</sup> Street, Suite 3200</b>			
City <b>Denver</b>	State <b>Colorado</b>	Zip Code <b>80202</b>	
Country <b>USA</b>	Telephone <b>303-295-8170</b>	Fax <b>303-295-8000</b>	
Name (Print/Type) <b>Brian P. Kinnear</b>		Registration No. (Attorney/Agent) <b>43,717</b>	
Signature 		Date <b>September 18, 2003</b>	

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<b>FEE TRANSMITTAL</b> <b>FOR FY 2003</b> <i>Patent fees are subject to annual revision</i>		<b>Complete if Known</b>	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 C.F.R. 1.27		Application Number	
		Filing Date	Herewith
		First Named Inventor	Mark Kerns et al.
		Examiner Name	not yet assigned
		Group Art Unit	not yet assigned
TOTAL AMOUNT OF PAYMENT (\$)		Attorney Docket No.	35693.830007.US0

<b>METHOD OF PAYMENT</b>		<b>FEE CALCULATION (continued)</b>																													
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		SUBTOTAL (3) (\$0.00)																													

<b>SUBMITTED BY</b>		<b>Complete (if applicable)</b>	
Name (Print/Type)	Brian Kinnear	Registration No. (Attorney/Agent)	43,717
Signature		Telephone	303-295-8170
		Date	September 11, 2003

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PATENT  
Attorney Docket No. 35693.830007.US0  
Express Mail No. EV269463365US

**IN RE UNITED STATES PATENT APPLICATION**

**FOR**

**MULTI-DENSITY LASTING BOARD**

**OF**

**MARK KERNS**

**AND**

**NOAH BERNARD**

## **MULTI-DENSITY LASTING BOARD**

### **FIELD OF THE INVENTION**

The present invention relates to shoes and, more particularly, to a sport shoe with a multi-density lasting board.

### **BACKGROUND OF THE INVENTION**

5 Shoes have been specialized and improved for years. Currently, shoe manufacturers and designers provide specialized shoes for many activities, such as, for example, running shoes, tennis shoes, cycling shoes, walking shoes, and cross-trainers. These shoes can be designed to respond to particular pressures and hot spots for the assumed usage.

10 However, shoe soles and/or inserts are typically designed as a largely consistent piece of rubber, typically a foam, or gel. While the consistent sole may be shaped and conformed to an individual's foot anatomy and is generally satisfactory, the cushion or support provided by the sole does not take into account different actions of the foot. As used in this application, the term cushion could mean more or less cushion depending on context. For example, during running, the metatarsal and heel portions of the foot are generally exposed to higher impact forces than the arch or instep. But the cushion or support provided by conventional shoe soles is uniform, despite this difference. Further, the toes are subject to pronation, but the sole or insert does not alter its cushion or support to help combat pronation.

15 In light of the above, it would be desirous to develop a multi-density lasting board or insert to provide varying cushion or support over the foot.

### **SUMMARY OF THE INVENTION**

25 To attain the advantages and in accordance with the present invention, a shoe is provided. The shoe comprises a sole and an upper forming an

interior foot portion and an exterior portion. A lasting board formed to overlay a sole portion in the interior foot portion comprises a first density foam portion and a second density foam portion. The second density is substantially contained in the first density foam portion and provides different cushioning over the sole.

The foregoing and other features, utilities and advantages of the invention will be apparent from the following more particular description of a preferred embodiment of the invention as illustrated in the accompanying drawings.

## **BRIEF DESCRIPTION OF THE DRAWING**

The accompanying drawings, which are incorporated in and constitute a part of this specification, illustrate embodiments of the present invention, and together with the description, serve to explain the principles thereof. Like items in the drawings are referred to using the same numerical reference.

FIG. 1 is a topside elevation of a multi-density shoe insert constructed in accordance with an embodiment of the present invention;

FIG. 2 is a cross-sectional elevation view of a shoe insert constructed in accordance with FIG. 1; and

FIG. 3 is a flowchart illustrative of one method of constructing a multi-density shoe insert consistent with the present invention.

## **DETAILED DESCRIPTION**

The present invention will be described with reference to FIGS. 1-3. While the present invention is shown and described with regard to a running shoe, one of ordinary skill in the art would recognize on reading the disclosure that alternative shoes styles could use the invention described herein, and the use of a running shoe is exemplary and non-limiting. Other styles of shoes that would benefit from the present invention include, without limitation, cycling shoes, sport cleats, basketball shoes, tennis shoes, and walking shoes

FIG. 1 shows a top elevation view of a multi-density lasting board 100 constructed in accordance with the present invention. While described as a lasting board fused to the sole during manufacturing (see FIG. 3 for more details on construction), one of ordinary skill in the art would recognize on reading the disclosure that board 100 could be designed as an insert to be inserted into a shoe subsequent to manufacturing. Such an insert could be inserted and permanently attached or inserted such that it is removable.

Board 100 comprises a heel portion 102, a mid-shoe portion 104 or midsole portion, and a toe box 106. Board 100 comprises at least two, but in this example, three different density foam sections. Largely, board 100 comprises a first density foam 108. Board 100 also comprises a second density foam 110 in the high impact areas of heel 102 and the metatarsal section of toe box 106. In this case, a third density foam 112 is located at the ball of the foot in toe box 106. As shown, second density foam 110 and third density foam 112 are substantially contained in first density foam 108.

Foams 108, 110, and 112 can be comprises of the same or different types of foams. Some types of foams include ethyl vinyl acetate foams, polyurethane forms, neoprene foams, and the like. All the foams could be open or closed cell foams as a matter of design choice. Moreover, the foams could be designed with moisture removal devices, such as, for example absorbents 114 or wicking materials 116. Absorbents 114 and wicking materials 116 are generally known in the art and will not be further explained herein. See for example, United States Patent No. 6,493,966, titled SOLE STRUCTURE FOR A SHOE OR AN INNER SOLE, issued December 17, 2002, to Braun, incorporated herein by reference and United States Patent No. 6,432,504, titled COMPOSITE TEXTILE FABRIC HAVING MOISTURE MANAGEMENT, issued August 13, 2002, to Yeh, incorporated herein by reference.

The actual locations of foams 110 and 112 (or more or less depending on the number of different density foams desired) are based on simple biometrics generally known in the art. Based on the biometrics, such as anatomy, gait, and the like, higher or lower density foams may be located.

Additionally, the increase or decrease in density can be calculated from the same biometrics. In the positions shown, foam 108 is a first density, foam 110 is a second lower density, and foam 112 is a third lowest density. In generally, the relatively higher density foams are placed under those sections of the foot that collapse, such as the toes, to provide added support to those areas. Relatively lower density foams are placed under more rigid areas of the foot, such as the heel to provide cushion. Using softer, less dense foams under areas of the foot that are rigid in combination with harder, more dense foams under the collapsing areas, the multi-density lasting board assists in guiding the foot through the gait cycle, heel to toe action. In some applications, it maybe desirable to have higher density foams under rigid areas of the foot and/or lower density foams under collapsible areas of the foot. Board 100 shows placement of foams 108, 110, and 112 assuming a running shoe. If, for example, board 100 was for a cycling shoe, foam 110 is heel portion 110 and may be removed because the heel is not subject to high impact. Placement of the different density foam is related in part to the use of the shoe.

Referring now to FIG. 2, a cross-sectional view of lasting board 100 is shown. In this case, lasting board 100 is shown mounted on a sole 202 of a shoe, including upper 206 (of which only a portion is shown). Sole and upper 206 define an internal cavity 208. Lasting board 100 is coupled to sole 202 using an adhesive layer 204. Adhesive layer 204 is generally known in the art and will not be further explained herein. Adhesive layer 204 can be a number of different materials, but it has been found that general purpose footwear cements that are heat activated and polyurethane based work well.

Referring now to FIG. 3, a flowchart 300 is provided illustrative of an method of constructing the lasting board described above. First, the lasting board is constructed out of a first density foam, step 302. One or more portions of the lasting board are removed, such as by die cutting, in locations where a second density foam (or a third density foam, etc.) is desired, step 304. For example, in FIG. 1, a section consistent with second density foam 110 was removed from heel portion 102 of lasting board 100. Other density

foam sections are constructed to be inserted into the portions removed in step 304, step 306. The other density foam sections are inserted into the removed portions, step 308, and fused to the first density foam, step 310, such as by a heat activated adhesive or the like.

- 5            Optionally, a section of second density foam could be removed, such as by die cutting, and a third density foam, or the first density foam, could be inserted into the second density foam as desired.

          Lasting board 100 could be sold as an insert to be inserted into a shoe by a user. Optionally, however, lasting board 100 is placed on sole 202, step  
10 312, and adhered to sole 202 using an adhesive 204, step 314.

          While the invention has been particularly shown and described with reference to an embodiment thereof, it will be understood by those skilled in the art that various other changes in the form and details may be made without departing from the spirit and scope of the invention.

We claim:

1. A multi-density lasting board for a shoe, comprising:  
a first density foam portion shaped to overlay a sole of the shoe;  
a second density foam portion; and  
the second density foam portion being substantially contained in the  
5 first density foam portion to provide different cushioning over the sole.
2. The multi-density lasting board according to claim 1, further comprising a third density foam portion being substantially contained in the first density foam portion.
3. The multi-density lasting board according to claim 1, wherein the first density foam portion and the second density foam portion comprise different types of foam.
4. The multi-density lasting board according to claim 2, wherein the first density foam portion, the second density foam portion, and the third density foam portion comprise at least two different types of foam.
5. The multi-density lasting board according to claim 1, wherein the first density foam is a higher density than the second density foam.
6. The multi-density lasting board according to claim 1, wherein the first density foam is a lower density than the second density foam.
7. The multi-density lasting board according to claim 1, wherein the first density foam is located about collapsible portions of a foot and is a higher density than the second density foam, the second density foam is located about the rigid portions of a foot.
8. The multi-density lasting board according to claim 7, wherein the second density foam is located at least about a heel of the foot.
9. The multi-density lasting board according to claim 7, wherein the second density foam is located at least about a metatarsal of the foot.
10. The multi-density lasting board according to claim 8, wherein the second density foam is located at least about a metatarsal of the foot.
11. The multi-density lasting board according to claim 10, further comprising a third density substantially contained in the second density foam and located about a ball of the foot.



12. The multi-density lasting board according to claim 1, wherein the first density foam and the second density foam are selected from the group of foams consisting of ethyl vinyl acetate, polyurethane, and neoprene.

13. A shoe having a multi-density lasting board, comprising:  
a sole;  
an upper coupled to the sole;  
the upper and the sole forming an interior cavity;
- 5 a multi-density lasting board between the sole and the interior cavity comprising a first foam having a first density and at least a second foam having a second density; and  
an adhesive layer residing between the sole and the multi-density lasting board coupling the sole and the multi-density lasting board.
14. The shoe according to claim 13, wherein the multi-density lasting board comprises at least a third density foam.
15. The shoe according to claim 12, wherein the first foam and the second foam are the same type of foam.

16. A method of constructing a multi-density lasting board for a shoe, the method comprising the steps of:

constructing a lasting board from a first foam having a first density;  
strategically removing cutouts from the first form;

5 constructing inserts from at least a second foam having at least a second density;

inserting the constructed inserts into the strategically removed cutouts;

and

fusing the inserts to the first foam to form a multi-density lasting  
10 board.

17. The method according to claim 16, further comprising the steps of:

aligning the multi-density lasting board on with a sole of a shoe; and  
adhering the multi-density lasting board to the sole.

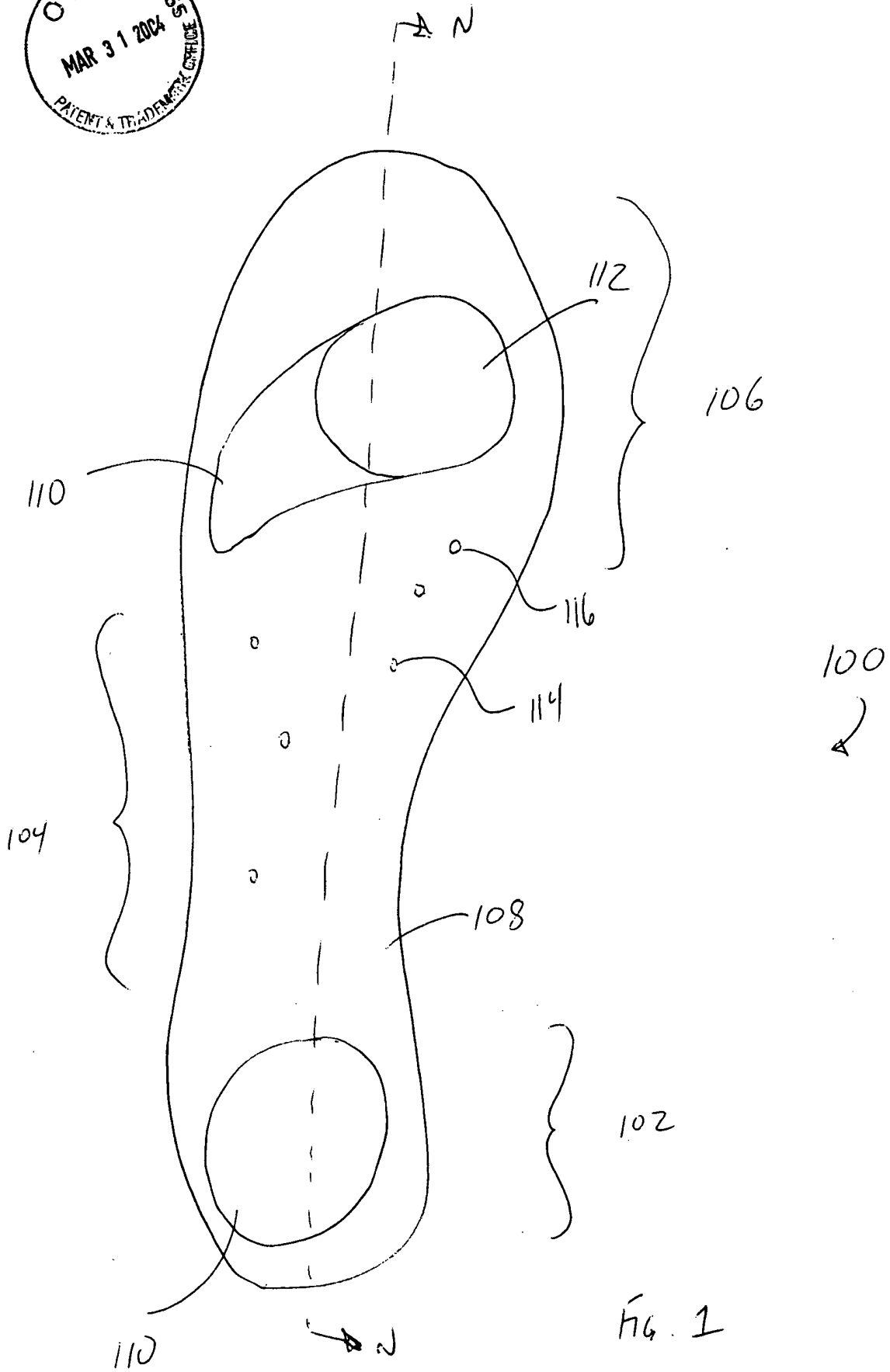
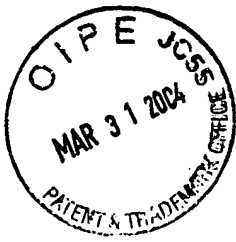
18. A shoe having a multi-density lasting board, comprising:  
a sole;  
an upper coupled to the sole;  
the upper and the sole forming an interior cavity;
- 5 means for providing differing amounts of cushioning coupled to the sole to provide predetermined amounts of cushioning to predetermined portions of a foot.
19. The shoe according to claim 18, wherein the means for providing differing amounts of cushioning comprises using different density foams along the sole.

## **ABSTRACT**

The present invention relates to a multi-density lasting board for a shoe. The multi-density lasting board comprises at least a first density foam and a second density foam contained substantially within the first density  
5 foam. The second density foam is placed to provide additional cushion or support to selected portions of the foot based on basic biometrics, anatomy, and individual comfort.

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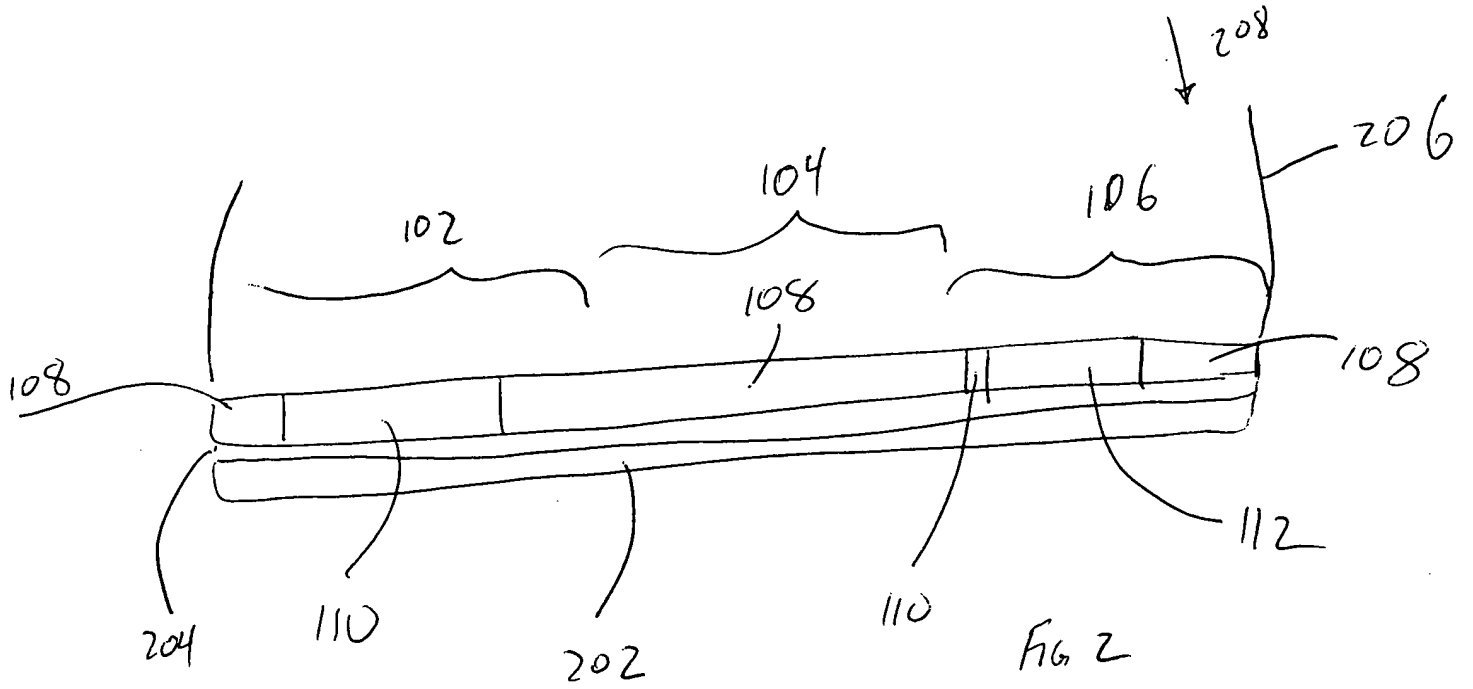
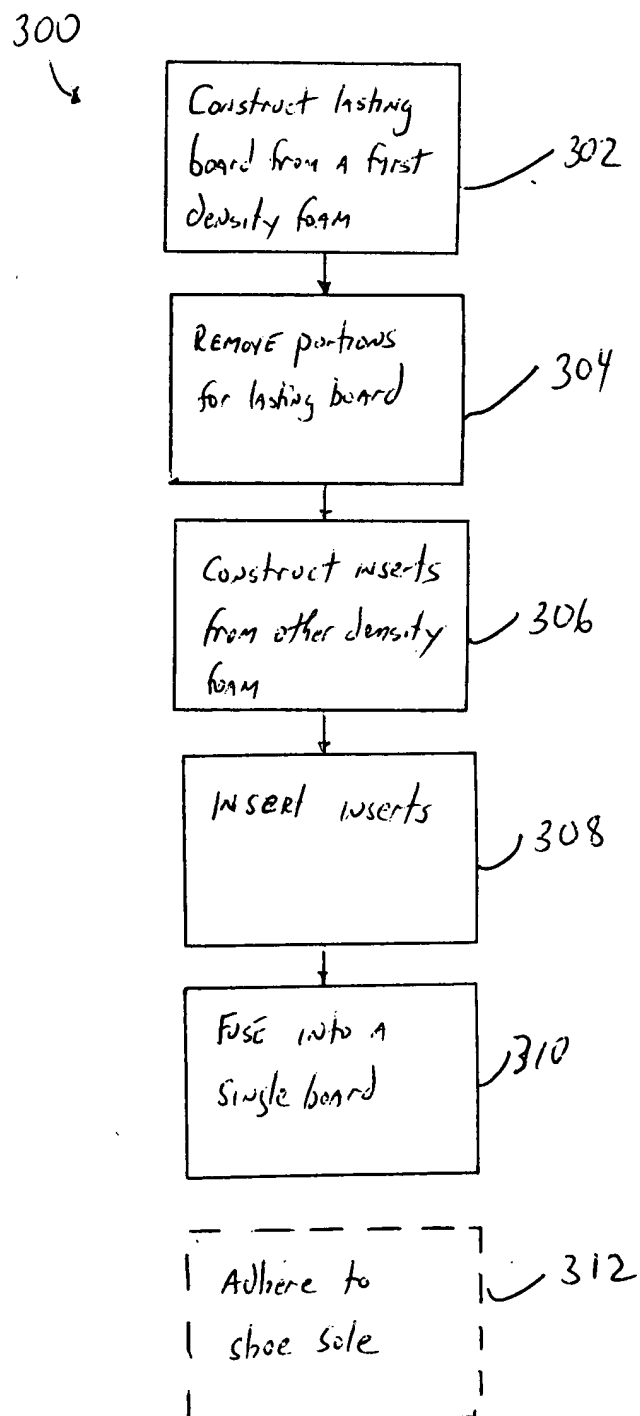




Fig. 3







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BRIAN P. KINNEAR  
HOLLAND & HART  
SUITE 3200  
555 17TH STREET  
DENVER CO 80202

**RECEIVED**

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**OFFICE OF PETITIONS**

In re Application of  
Kerns and Bernard  
Application No. 10/665,909  
Filed: 18 September, 2003  
Atty Docket No. 35693.830007.USO

:  
: DECISION REFUSING STATUS  
: UNDER 37 CFR 1.47(a)  
:

This is in response to the petition filed under 37 CFR 1.47(a) on  
29 January, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of  
this decision to reply, correcting the below-noted deficiencies.  
Any reply should be entitled "Request for Reconsideration of  
Petition Under 37 CFR 1.47(a)," and should only address the  
deficiencies noted below, except that the reply may include an  
oath or declaration executed by the non-signing inventor.  
**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR  
1.136(a).

The above-identified application was filed on 18 September, 2003,  
without an executed oath or declaration. Accordingly, on 11  
December, 2003, a Notice to File Missing Parts of Nonprovisional  
Application was mailed, requiring, *inter alia*, an executed oath  
or declaration and a surcharge for its late filing.

In response, on 29 January, 2004, petitioners filed a declaration  
naming Mark Kerns and Noah Bernard as joint inventors, signed by  
joint inventor Kerns, and the late-filing surcharge.

Petitioners state that joint inventor Bernard cannot be contacted  
to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not provided proof that Bernard was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).<sup>1</sup> While the petition states that a copy of the application, claims, and drawings were sent to joint inventor Bernard's last known address, it is unclear from the petition whether the statement was made by a person with first-hand knowledge that the documents were in fact sent.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

In regards to item (2), the declaration present with the present petition is defective in that it lacks the residence and mailing address of non-signing inventor Bernard. The oath or declaration

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<sup>1</sup> MPEP 409.03(d).

must identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.<sup>2</sup> Petitioners must submit a new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor.

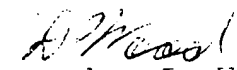
Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                  Attn: Office of Petitions

By hand:          U.S. Patent and Trademark Office  
                  2011 South Clark Place  
                  Customer Window  
                  Crystal Plaza 2, Lobby, Room 1B03  
                  Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

  
Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

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<sup>2</sup>37 CFR 1.63(c).

SUPPLEMENTAL  
COMBINED DECLARATION AND POWER  
OF ATTORNEY FOR PATENT APPLICATION

DECLARATION:

As the below named inventors, we hereby declare that:

Our residences, post office addresses and citizenships are as stated below next to our names.

We believe we are original, first and joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled MULTI-DENSITY LASTING BOARD, the specification of which is filed on September 18, 2003, Serial No. 10/665,909 under attorney docket number 35693.830007.US0.

The persons named as inventors in this application are Mark Kerns and Noah Bernard.

We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims.

We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56. If this application is identified above as a continuation-in-part application above, we acknowledge the duty to disclose to the Office all information known to us to be material to patentability as defined in §1.56 which became available between the filing date of the prior application and the filing date of this continuation-in-part application.

No prior foreign application for patent or inventors' certificate has been filed.

No priority claim is made.

Application No.	Filing Date	Status

**POWER OF ATTORNEY:**

As named inventor, I hereby appoint Francis A. Sirr, Reg. No. 17,265, Brian P. Kinnear, Reg. No. 43,717, Chris Kulish, Reg. No. 33,056 and L. Grant Foster, Reg. No. 33,236, Trent Baker, Reg. No. 46,534, James R. Farmer, Reg. No. 47,555, Thomas Osborne, Reg. No. 39,796, and Chris Wight, Reg. No. 31,680 to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. Send all correspondence to: Brian Kinnear, HOLLAND & HART LLP, P.O. Box 8749, Denver, Colorado 80201, and direct telephone calls to Brian Kinnear, telephone number 303-295-8170.

We hereby declare that all statements made herein of my own knowledge are true and that all

However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office,  
or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

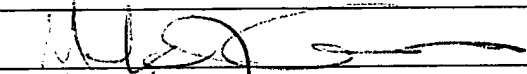
(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Each other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor.

statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor's Full Name:	Mark Kerns
Inventor's Signature:	
Date:	3/29/04
Residence: (City, State and/or Country)	934 La Salle Street Superior, Colorado 80027
Citizenship:	USA
Post Address Office:	Same as above

Inventor's Full Name:	Noah Bernard
Inventor's Signature:	
Date:	
Residence (City, State and/or Country)	410 Washington #13 Santa Fe, New Mexico 87501
Citizenship:	USA
Post Address Office:	Same as above

**§ 1.56 duty to disclose information material to patentability.**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98.